

In re Application of:
Adams et al.

Filed: August 25, 1993

For: METHODS AND COMPOSITIONS
FOR THE PRODUCTION OF
STABLY TRANSFORMED,
FERTILE MONOCOT PLANTS
AND CELLS THEREOF

[illegible]

Group Art Unit: 1804

Examiner: G. Benzion

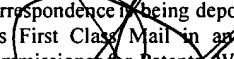
Atty. Dkt.: DEKM:055/PAR

CERTIFICATE OF MAILING
37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington D.C. 20231, on the date below:

September 23, 1996

Date



David L. Parker

Commissioner of Patents
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The present paper is submitted under 37 C.F.R. § 1.116, 1.127 and 1.181 to request the Commissioner to order the entry of the amendments to the claims presented concurrently with the Reply Brief in the referenced case. Section 1.127 provides that, upon the refusal of

the primary examiner to admit an amendment the Applicant may petition to the Commissioner under § 1.181. Section 1.181 sets forth the circumstances under which a petition may be made and the requirements for the contents of the petition.

It is believed that no fee is required, however, should the Commissioner of Patents and Trademarks determine that additional fees are necessary, the Commissioner is hereby authorized to deduct said fee from Arnold, White & Durkee Deposit Account No. 01-2508/UTSD:397/PAR.

I. History of the Case

The present application was originally filed on August 25, 1993 with claims 1-67. In the First Official Action dated June 28, 1994, claims 1-67 were rejected. In a Response mailed December 28, 1994, claims 1, 5-46 and 48-49 were canceled without prejudice, claims 2-4, 47, 56, 57 and 61 were amended and a request was made for insertion of text into the specification to partially correct an unintentional deletion of text from the specification.

In the Final Official Action dated April 17, 1995, claims 2-4, 47 & 50-67 were rejected. The Examiner objected to the insertion of text into the specification as new matter under 35 U.S.C. § 132 and required the Applicant to cancel the inserted text.

In a Response to Final Office Action and Request for Amendment under 37 C.F.R. § 1.16, mailed June 12, 1995, claims 47, 60 and 63-67 were amended. An Advisory Action mailed on July 27, 1995 entered the amendments and rejected claims 2-4, 47 and 50-67.

A Notice of Appeal was filed October 10, 1995. Appellants contemporaneously

submitted with their Appeal Brief amendments to claims 47, 61 and 64 to simplify the issues for appeal. Appellants also contemporaneously filed a Petition to the Commissioner under 37 C.F.R. § 1.181(a) to petition for the entry of new text into the specification as originally requested on December 28, 1994.

An Advisory Action mailed January 31, 1996 rejected claims 2-4, 47, 50-58 and 60-67. The amendments to claims 47, 61 and 64 were entered as they materially reduced the issues under appeal.

On February 8, 1996 the Petition to the Commissioner filed on October 18, 1995 was granted, since the added language was supported by the specification as originally filed and did not change the invention described in the application, it was held not to be new matter.

The Examiner's Answer to Appellant's Brief was mailed on March 7, 1996. A Reply Brief was filed on May 7, 1996. Appellants contemporaneously submitted with their Reply Brief an amendment to claim 66 and a request to cancel without prejudice claims 50, 53 and 54. These claims were dependent upon claims which had been previously amended, leaving claims 50, 53 and 54 without antecedent basis.

In an Advisory Action mailed on July 23, 1996, the Examiner refused to enter the requested amendment to claim 66 and the requested cancellations of claims 50, 53 and 54 on the grounds that further search and/or consideration would be required to determine if new art would be necessary to meet remaining claim limitations. The Advisory Action indicated that cancellation of claim 50, if presented separately, would be entered. The Examiner also refused to enter the Reply Brief, stating that it was not limited to new points of argument or to

new grounds of rejection raised in the Examiner's Answer. A revised Reply Brief is submitted herewith. A separately presented request to cancel claim 50 without prejudice is also submitted herewith. Claims 2-4, 47, 50-58 and 60-67 are presently the subject of appeal.

II. Rules Governing Entry of Amendments After Final Rejection

The rules and guidelines governing the entry of amendments after final rejection and contemporaneously with appeal are straightforward. The rule addressing amendments made after final rejection, 37 C.F.R. § 1.116(a), provides in pertinent part:

(a) After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted.

37 C.F.R. § 1.116(a) (1995). Subsection (b) of this rule sets forth the circumstances under which a showing of good and sufficient reasons why the amendments to be entered are necessary and were not earlier presented is required. Appellants submit that such a showing is not necessary in the present case for reasons set forth below.

The Manual of Patent Examining Procedure (MPEP) sets forth guidelines for examiners to follow when presented with amendments after final rejection and/or upon or after filing of an appeal in §§ 714.13 and 1207. Both of these sections provide that "where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner," a showing under 37 C.F.R. § 1.116(b) is not necessary. MPEP §§ 714.13, p. 700-114; 1207, p. 1200-12 (Sept.

1995). Appellants submit that the amendments presented contemporaneously with their Reply Brief had the effect of removing issues for appeal and adopting examiner suggestions and should therefore be entered. Specific facts relating to Appellants position are set forth in Section III below.

MPEP § 714.13 further explains that "[t]he refusal to enter the proposed amendment should not be arbitrary." Moreover, the examiner is required to give the proposed amendment "sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified" and to concisely express her reasons for nonentry of the amendments. MPEP § 714.13, p. 700-114. The Action states that the amendments "raise new issues that would require further consideration and/or search." Appellants disagree with this position and explain in more detail below the reasons Appellants believe the amendments should be entered.

III. Facts Involved and Points to be Reviewed

The Advisory Action mailed on July 23, 1996 refused to enter the requested cancellation of claims 53 and 54. The Examiner indicated that such cancellation would raise the issue of new matter, as the removal of this subject matter would affect the scope of the remaining claim limitations, requiring further search and/or consideration to determine if new art would be necessary.

Appellants note that claims 53 and 54 depend from claim 47. A request to amend claim 47 was filed on October 18, 1995. The amendment was entered in the Advisory Action

mailed on January 31, 1996.

The amendment of claim 47 entered on January 31, 1995 read as follows:

47. (three times amended) A fertile, transgenic maize plant, the genome of which has been augmented by the introduction of a DNA composition comprising a selectable or screenable marker gene selected from the group of genes consisting of [**a dalapon dehalogenase (*deh*) gene; an anthranilate synthase gene that confers resistance to 5 methyl tryptophan;**] an aequorin gene and a gene encoding a cell wall protein, so that the transgenic plant exhibits one or more phenotypic characteristics that render it identifiable over the corresponding untransformed maize plant which does not comprise said gene, and wherein said gene is transmittable through normal sexual reproduction of the transgenic maize plant to subsequent generation plants.

Claims 53 and 54 presently read as follows:

53. The transgenic maize plant of claim 47, wherein the selectable or screenable marker gene comprises **a dalapon dehalogenase (*deh*) gene.**

54. The transgenic maize plant of claim 47, wherein the selectable or screenable marker gene comprises **an anthranilate synthase gene that confers resistance to 5 methyl tryptophan.**

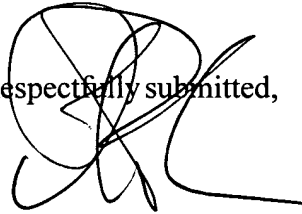
Appellants submit that claims 53 and 54 are without antecedant basis following the amendment of claim 47 entered by the Advisory Action dated January 31, 1996. Specifically, reference in claim 47 to “a dalapon dehalogenase gene” and “an anthranilate synthase gene” has been removed. Neither of these two genes constitutes an aequorin gene or a gene

encoding a cell wall protein. Therefore, claims 53 and 54 are without any antecedent basis whatsoever in the currently pending claims. In order to simplify the issues on appeal, Appellants request that the Commissioner order the entry of the amendments.

IV. Conclusion

Appellants respectfully submit that, from the foregoing observations and arguments, the Action's conclusion that the proposed amendments may not be entered is unwarranted. It is therefore requested that the Commissioner order the entry of the amendments in order to simplify issues for appeal.

Respectfully submitted,



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